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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/930,786	08/15/2001	Ronald E. Sloan	60021-375602	3301

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EXAMINER

NGUYEN, NGA B

ART UNIT	PAPER NUMBER
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3628

DATE MAILED: 06/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/930,786

Applicant(s)

SLOAN ET AL.

Examiner

Nga B. Nguyen

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 February 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-42 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-42 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 11/26/04;2/18/05.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. This Office Action is the answer to the communication filed on February 17, 2005, which paper has been placed of record in the file.
2. Claims 1-42 are pending in this application.

Response to Arguments/Amendment

3. Applicant's arguments with respect to claims 1-42 have been considered but are not persuasive.

In the arguments regarding to claims 1, 2, 6-12, 14, 15, 30, 31, 35-39, 41, and 42, which are rejected under 35 U.S.C. 102(e) as being anticipated by Wallman, applicant stated that Wallman does not teach the limitation "providing to the user over an Internet customized financial coaching tailored to life intentions of the user". Examiner respectfully disagrees. See Wallman column 28, lines 10-27, the investor access the system over the Internet; column 24, lines 1-25; column 26, lines 28-35; column 31, lines 30-50, the system suggests for changes to the current financial portfolio to satisfy the investor's preferences, column 14, lines 45-57; column 25, lines 23-65; column 26, lines 10-65; column 30, line 32-column 31, line 15; the system recommends the portfolios including a lists of securities for the investor to purchase. Thus, the system of Wallman alerts the customer to issues which need to be address, bring decision which need to be made, signals customers when certain strategic condition obtain (e.g. the system suggests for changes to the current financial portfolio to satisfy the investor's preferences, the system recommends the portfolios including a

lists of securities for the investor to purchase, etc.). Therefore, Walman does teach the coaching feature in the claimed invention.

In response to applicant's arguments regarding to claims 3 and 32, which are rejected under 35 U.S.C. 103 (a) as being unpatentable over Wallman in view of Rebane, that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the system of Wallman provides the user the recommended portfolio based on the investor's risk tolerance level, in addition, the system of Rebane determines the investor's risk tolerance level in a specific way which is missing in Wallman. Therefore, adopting the teaching of Rebane provides Walman's system more efficiency in determining the investor's risk tolerance level. Examiner also submits that the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

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In response to applicant's arguments regarding to claims 4, 5, 13, 27, 33, 34, and 40, which are rejected under 35 U.S.C. 103 (a) as being unpatentable over Wallman, that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, modify Wallman's to include determining the bull/bear attitude has the purpose of providing more efficiency in determining the investor's investment style and bull/bear attitude in order to suggesting and recommending securities for the investor to purchase.

In response to applicant's arguments regarding to claims 16, 17, 19-26, and 28-29, which are rejected under 35 U.S.C. 103 (a) as being unpatentable over Wallman in view of Deep, that neither Wallman nor Deep teach the computer coaching feature, the examiner emphasizes that Wallman does teach the computer coaching feature (see above), therefore, the claims are unpatentable over the combination of Wallman and Deep.

In response to applicant's arguments regarding to claim 18, which is rejected under 35 U.S.C. 103 (a) as being unpatentable over Wallman in view of Deep and further in view of Rebane, that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or

modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the system of Wallman provides the user the recommended portfolio based on the investor's risk tolerance level, in addition, the system of Rebane determines the investor's risk tolerance level in a specific way which is missing in Wallman, the system of Deep allows the investor to communicate with the live financial advisor to recommends changes to the financial portfolio based on the investor profile. Therefore, adopting the teaching of Rebane provides Walman's system more efficiency in determining the investor's risk tolerance level, adopting the teaching of Deep for the purpose of allowing the investor to communicate directly with a live financial advisor, thus the investor can get the recommended securities to purchase directly from a live financial advisor. Examiner also submits that the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

In conclusion, for the reason set forth above, examiner decides to maintain the previous rejection (also see details below) and make this Office action FINAL.

4. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1, 2, 6-12, 14, 15, 30, 31, 35-39, 41, and 42 are rejected under 35 U.S.C. 102(e) as being anticipated by Wallman, U.S. Patent No. 6,601,044.

Regarding to claim 1, Wallman discloses a method for developing a web-based financial portfolio remotely over the Internet comprising:

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identifying a current financial portfolio of a user (column 23, line 62-column 24, line 25; the investor selects his desired portfolio based on his various preferences);

identifying a user profile based on personal financial parameters of the user including at least a risk tolerance level (column 23, lines 20-40; column 29, lines 10-20 and figure 2; the investor creates new account with the system, the system creates the investor's profile including name, address, payment information, the investor's risk tolerance, financial goals, objectives, the investor's current assets and liabilities, current and expected income, etc.); and

providing to the user over an Internet customized financial coaching tailored to life intentions of the users, wherein the customized financial coaching includes suggestions for changes to the current financial portfolio reflecting the user profile (column 28, lines 10-27, the investor access the system over the Internet; column 24, lines 1-25; column 26, lines 28-35; column 31, lines 30-50; the system suggest for changes to the current financial portfolio to satisfy the investor's preferences), wherein the suggestions are presented in a natural language format (column 38, line 55-column 39, line 35; column 32, lines 40-60) and wherein the suggestions include financial products and recommended securities for user to purchase (column 14, lines 45-57; column 25, lines 23-65; column 26, lines 10-65; column 30, line 32-column 31, line 15; the system recommends the portfolios including a lists of securities for the investor to purchase).

Regarding to claim 2, Wallman discloses wherein the personal financial parameters further include: a user investment style; and a user bull/bear market attitude

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(column 23, lines 35; column 26, lines 10-15; column 29, line 58-column 30, line 25; the investor's preference).

Regarding to claim 6, Wallman discloses filtering a list of securities based on the user profile, wherein filtering the list of securities yields the recommended securities; and presenting the recommended securities to the user for possible security swaps, wherein securities can be added to or removed from the portfolio (column 26, lines 28-35).

Regarding to claim 7, Wallman discloses wherein filtering the list of securities comprises:

obtaining a Value At Risk (VAR) value and a Beta value for each security in the list of securities (figures 5, 13 and column 37, lines 58-66; Differential return relative to S&P 500 56b-56h is VAR, risk relative to S&P 500 55b-55h is beta value);

rejecting securities in the list of securities not complying with the user profile based on the VAR values and the Beta values (column 26, lines 5-10).

Regarding to claim 8, Wallman discloses wherein a risk management model is used to calculate a user VAR value and a user Beta value for the portfolio (column 14, lines 10-18; the risk an differential return calculation process calculates risk and a differential return of the entire investor portfolio relative to standard industry measurements or absolute values).

Regarding to claim 9, Wallman discloses comparing the user VAR value and the user Beta value to a VAR value and a Beta value of various user selected market

indices; and displaying the result to the user in a graph (column 26, lines 37-45 and column 32, lines 29-67).

Regarding to claims 10-11, Wallman discloses wherein a compound growth factor is calculated by: using linear regression and natural logarithm and wherein a future performance of the portfolio is projected using the compound growth factor (figure 13, the expected differential in portfolio return is calculated relative to S&P 500).

Regarding to claim 12, Wallman discloses comprising: allowing the user to select at least one security from the filtered list of securities; swapping the selected securities with securities in the portfolio; and analyzing and displaying the effect of said swapping on the portfolio (column 26, lines 28-45).

Regarding to claim 14, Wallman discloses wherein a financial model developer creates an ideal portfolio based on the user profile (column 25, lines 23-30; column 30, line 32-column 31, line 15).

Regarding to claim 15, Wallman discloses wherein the user has access to automated computer coaching and live coaching based on a service level agreement (column 29, lines 37-50; the system determines whether the investor is an accredited investor or a qualified investor; column 35, lines 3-15; the accredited investor can engage in chat room activities).

Claims 30, 31, 35-39, 41, 42 are written in computer software that parallel the limitations found in claims 1, 2, 6-9, 12, 14, 15 above, therefore, are rejected by the same rationale.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 3 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wallman, U.S. Patent No. 6,601,044, in view of Rebane, U.S. Patent No. 6,078,904.

Regarding to claims 3 and 32, Wallman does not disclose wherein said user risk tolerance level is determined by: displaying to the user a series of progressively more negative financial scenarios; analyzing a response to each negative scenario received the user; and generating the risk tolerance level based on the user's responses.

However, Rebane discloses wherein said user risk tolerance level is determined by: displaying to the user a series of progressively more negative financial scenarios; analyzing a response to each negative scenario received the user; and generating the risk tolerance level based on the user's responses (column 17, line 48-column 22, line 45). Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify Wallman's to adopt the teaching of Rebane for the purpose of providing more efficiency in determining the investor's risk tolerance level in order to suggesting and recommending securities for the investor to purchase.

9. Claims 4, 5, 13, 27, 33, 34, and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wallman, U.S. Patent No. 6,601,044.

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Regarding to claims 4, 5, 33, and 34, Wallman does not disclose wherein said user investment style is determined by: displaying to the user a series of test scenarios; and generating said user investment style based on the user responses to these test scenarios and wherein said user bull/bear attitude is determined by: displaying a series of user selected expert opinions; analyzing the user's response to the opinions; and generating said user bull/bear attitude based on the user responses. However, it is well known in the art to determine investment style and bull/bear attitude based on the user responses the series of questions. Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify Wallman's to include the feature above for the purpose of providing more efficiency in determining the investor's investment style and bull/bear attitude in order to suggesting and recommending securities for the investor to purchase.

Regarding to claims 13, 27, and 40, Wallman does not disclose wherein the filtered list of securities is displayed in a first column and a second column, wherein securities with positive Beta values are displayed in the first column and securities with negative Beta values are displayed in the second column. However, Wallman does disclose filtered list of securities is displayed in a first column and Beta values are displayed in a second column (see figures 5 and 13). Moreover, it is well known in the art to display the securities with positive Beta values in the first column and the securities with negative Beta values in the second column. Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to

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modify Wallman's to include the feature above for the purpose of helping the investor more easily in selecting securities to purchase.

10. Claims 16, 17, 19-26, 28, 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wallman, U.S. Patent No. 6,601,044, in view of Deep, U.S. Patent No. 6,393,412.

Regarding to claim 16, Wallman discloses a system for developing a web-based financial portfolio remotely over the Internet comprising:

a portfolio generator used to model a current financial portfolio for a user (figure 1; column 23, lines 10-20; column 25, line 65-column 26, line 10; the portfolio selection editor 2);

a user profile generator for generating a user profile based on personal financial parameters of the user, wherein the user profile includes at least a risk tolerance level (figure 1 and column 23, line 10-47; the asset allocation model 1);

a computer coaching server coupled to the Internet (figure 1; column 23, lines 20-20, the web server 3 or figure 6; column 28, lines 10-37, the web server 14), wherein the computer coaching server provides automated financial coaching presented in a natural language format (column 38, line 55-collumn 39, line 35; column 32, lines 40-60); wherein said computer coaching server recommends changes to the financial portfolio based on the user profile, including providing customized financial coaching tailored to the life intentions of the user and providing suggestions of financial products and recommended securities for the user to purchase (column 25, lines 23-65; column

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26, lines 10-65; column 30, line 32-column 31, line 15; the system recommends the portfolios including a lists of securities for the investor to purchase).

Wallman does not disclose a live financial advisor server coupled to the Internet recommends changes to the financial portfolio based on the user profile, including providing customized financial coaching tailored to the life intentions of the user and providing suggestions of financial products and recommended securities for the user to purchase. However, Deep discloses a live financial advisor server coupled to the Internet recommends changes to the financial portfolio based on the user profile, including providing customized financial coaching tailored to the life intentions of the user and providing suggestions of financial products and recommended securities for the user to purchase (column 3, lines 17-30 and column 5, line 28-column 6, line 5; the user and the financial advisor can communicate via a chat room over the Internet, the advisor recommends changes to the financial portfolio based on the user profile, recommends the securities to sell or purchase). Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify Wallman's to adopt the teaching of Deep for the purpose of allowing the investor to communicate directly with a live financial advisor, thus the investor can get the recommended securities to purchase directly from a live financial advisor.

Claims 17, 21-26, 28, 29 have similar limitations found in claims 2, 6-12, 14, 15 above, therefore are rejected by the same rationale.

Regarding to claims 19-20, Wallman and Deep do not disclose wherein said user investment style is determined by: displaying to the user a series of test scenarios; and

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generating said user investment style based on the user responses to these test scenarios and wherein said user bull/bear attitude is determined by: displaying a series of user selected expert opinions; analyzing the user's response to the opinions; and generating said user bull/bear attitude based on the user responses. However, it is well known in the art to determine investment style and bull/bear attitude based on the user responses the series of questions. Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify the system of Wallman modified by Deep above to include this feature for the purpose of providing more efficiency in determining the investor's investment style and bull/bear attitude in order to suggesting and recommending securities for the investor to purchase.

11. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wallman, U.S. Patent No. 6,601,044, in view of Deep, U.S. Patent No. 6,393,412, further in view of Rebane, U.S. Patent No. 6,078,904.

Regarding to claim 18, Wallman and Deep do not disclose wherein said user risk tolerance level is determined by: displaying to the user a series of progressively more negative financial scenarios; analyzing a response to each negative scenario received the user; and generating the risk tolerance level based on the user's responses. However, Rebane discloses wherein said user risk tolerance level is determined by: displaying to the user a series of progressively more negative financial scenarios; analyzing a response to each negative scenario received the user; and generating the risk tolerance level based on the user's responses (column 17, line 48-column 22, line 45). Therefore, it would have been obvious to one with ordinary skill in the art at the

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time the invention was made to modify Wallman's modified by Deep above to adopt the teaching of Rebane for the purpose of providing more efficiency in determining the investor's risk tolerance level in order to suggesting and recommending securities for the investor to purchase.

Conclusion

12. Claims 1-42 are rejected.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner Nga B. Nguyen whose telephone number is (571) 272-6796. The examiner can normally be reached on Monday-Thursday from 9:00AM-6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hyung S. Sough can be reached on (571) 272-6799.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (571) 272-3600.

14. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

C/o Technology Center 3600

Washington, DC 20231

Or faxed to:

(703) 872-9306 (for formal communication intended for entry),

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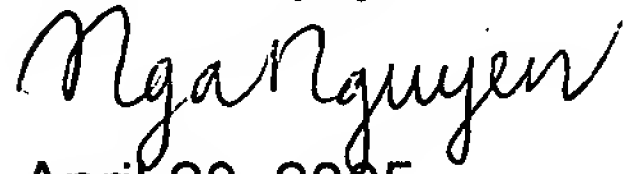
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or

(571) 273-0325 (for informal or draft communication, please label
"PROPOSED" or "DRAFT").

Hand-delivered responses should be brought to Knox building, 401 Dulany
Street, Alexandria, VA, First Floor (Receptionist).

Nga B. Nguyen

A handwritten signature in cursive script that reads "Nga Nguyen".

April 20, 2005